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<b>TO:</b> Commissioner for Patents	<b>COMPANY:</b> U.S. Patent & Trademark Office	<b>FAX #:</b> 571-273-8300
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<b>DATE:</b> <b>FROM:</b> <b>OPERATOR:</b> <b>CLIENT/MATTER:</b> <b>PAGES:</b>	<b>August 25, 2005</b> Morgan S. Heller Karen Jeffer 07689-00030 32 (including cover)	<i>MSH</i>

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## Comments

BTV.255986.1

COURTHOUSE PLAZA ■ 199 MAIN STREET ■ PO BOX 190 ■ BURLINGTON, VT ■ 05402-0190 ■ T: +1.802.863.2375 ■ F: +1.802.862.7512  
BURLINGTON, VT ■ ST. JOHNSBURY, VT ■ BRATTLEBORO, VT ■ MONTPELIER, VT ■ LITTLETON, NH ■ WWW.DRM.COM

PAGE 1/32 \* RCVD AT 8/25/2005 11:38:03 AM [Eastern Daylight Time] \* SVR:USPTO-EFAX-6/26 \* DNIS:2738300 \* CSID:802 864 4906 \* DURATION (mm-ss):09-36

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PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: John E. Cronin

Serial No.: 09/766,456

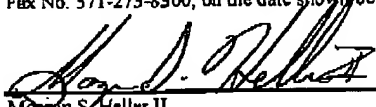
Filed: January 19, 2001

Title: Scanning Invention Process

Attorney Docket No.: ipCG-506  
(07689-00030)

Group Art Unit: 3629

Examiner: Janice A. Mooneyham

<input checked="" type="checkbox"/> CERTIFICATION OF FACSIMILE TRANSMISSION	
I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office. Fax No. 571-273-8300, on the date shown below.	
 Morgan S. Heller II	8/25/05 Date

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

August 25, 2005

## Response Transmittal

Transmitted herewith for filing is a Response to First Office Action with regard to the above-identified Application.

- ☒ No additional fee is required.
- ☐ The fee has been calculated as shown below:

P248-10/03

Page 1 of 2

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Downs Rachlin Martin PLLC  
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CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL 55	MINUS	56	= 0	x \$50.00/ \$25.00 =	\$0.00
INDEPENDENT 10	MINUS	10	= 0	x \$200.00/ \$100.00 =	\$0.00
1ST PRESENTATION OF MULTIPLE DEP. CLAIMS				\$360.00/ \$180.00 =	\$0.00
				TOTAL	\$0.00

- ☐ Check no. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_ is attached.
- ☐ Please charge Deposit Account No. 04-1588 in the amount of \$ \_\_\_\_\_. A duplicate copy of this sheet is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 04-1588. A duplicate copy of this sheet is enclosed.
- ☒ Any additional filing fees required under 37 C.F.R. §1.16.
- ☒ Any patent application processing fees under 37 C.F.R. §1.17.

Respectfully submitted,

DOWNS RACHLIN MARTIN PLLC

By: 

Morgan S. Heller II  
Attorney of Record  
Registration No.: 44,756  
Customer No. 21918  
Tel: (802) 863-2375

BTV.450780.1

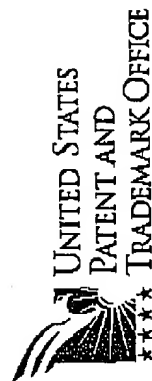
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Page 2 of 2

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P.O. Box 190  
Burlington, VT 05402-0190  
(802) 863-2375

# 35 U.S.C. 101 Training Materials

Presented by  
Vincent Millin, Tariq Hafiz, Jim Trammell and  
Robert Olszewski



# Steps carried Out in the Human Mind OK if Useful, Concrete and Tangible Result Produced

A method or process remains statutory even if some or all of the steps therein can be carried out:

- ❖ in the human mind
- ❖ with the aid of the human mind, or
- ❖ because it may be necessary for one performing the method or process to think. *In re Musgrave*, 431 F.2d 882, 893; 167 USPQ 280, 289 (CCPA 1970)

The key is that a useful, concrete and tangible result must be produced.

## "Useful"

The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

- (a) the utility need not be expressly recited in the claims, rather it may be inferred;
- (b) if the utility is not asserted in the written description, then it must be well established;
- (c) a specific, substantial and credible utility must be accomplished.